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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,493	10/27/2000	Billy G. Anderson	LN.013C4	3853
24395	7590	01/30/2004		
HALE & DORR LLP THE WILLARD OFFICE BUILDING 1455 PENNSYLVANIA AVE, NW WASHINGTON, DC 20004			EXAMINER PRIDY, MICHAEL B	
			ART UNIT	PAPER NUMBER
			3732	19
DATE MAILED: 01/30/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/698,493

Applicant(s)

ANDERSON ET AL.

Examiner

Michael B Priddy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 110-139 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 117-119, 120/117-119, 133/117, 134/133/117, 136/120/117-119 and 139/134/133/117 is/are allowed.
- 6) ☒ Claim(s) 110-116, 120/110-115, 121-132, 133/110-115 and 134-139 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

The proposed drawing correction and/or proposed substitute sheets of drawings, filed 04/03/2002 have been approved by the examiner. A proper drawing correction or corrected drawings are required in reply to this Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 112 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyer, II et al. (U.S. 2001/0041941) in view of Boyce et al. (U.S. 6,123,731). Boyer, II et al. teaches a composite bone graft, comprising (as shown in Figs. 2B-2D) six distinct, adjacent, cortical bone portions wherein said composite bone graft does not comprise an adhesive and said cortical bone portions are not demineralized. Note paragraph 0075 wherein Boyer, II et al. indicates "the implants described herein may be formed of bone materials with varying mineral content. For example, cancellous or cortical bone may be provided in natural, partially demineralized or demineralized states." Hence Boyer, II et al. teaches all of the limitations of the present invention except the cortical

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bone portions each comprising a face complimentary to a face on an adjacent cortical bone portion, each face comprising a single projection or a single depression, such that adjacent faces are complimentary, and a single projection interlocks with a single depression, to provide an interlocking fit between said adjacent bone portions.

Boyce et al. teaches a related composite bone graft comprising portions of demineralized and partially demineralized cancellous and cortical bone wherein said portions each comprising a face complimentary to a face on an adjacent cortical bone portion, each face comprising a single projection or a single depression, such that adjacent faces are complimentary, and a single projection interlocks with a single depression, to provide an interlocking fit between said adjacent bone portions (tongue-and-groove features as mentioned in lines 64-65 of column 5 of ). This method of joining bone portions is used "in those embodiments of the osteoimplant which are assembled from relatively large bone-derived elements such as sheets" and "facilitates their assembly into the final product and/or to fix the elements to each other in a more secured fashion." It would have been obvious to one of ordinary skill in the art at the time of the present invention to use tongue-and-groove features to join the cortical bone portions of Boyer, II et al. to facilitate assembly of relatively large bone-derived elements such as sheets.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 110-116, 120/110-115, 121-132, 133/110-115 and 134-139 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,200,347. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are claiming what is essentially the same structure only in some cases in slightly different and/or broader language.

### ***Terminal Disclaimer***

The terminal disclaimer does not comply with 37 CFR 1.321(b) and/or (c) because:

The disclaimer fee of 455.00 in accordance with 37 CFR 1.20(d) has not been submitted, nor is there any authorization in the application file to charge a specified Deposit Account or credit card.

***Response to Amendment***

The amendment to Claims 124 and 125 has overcome the rejection under 35 USC 112, second paragraph.

The amendment to Claim 117 has overcome the rejections of claims 117-119, 120/117-119, 133/117, 134/133/117, 136/120/117-119 and 139/134/133/117 under 35 USC 103(a) and the Obvious Double Patenting rejection of claims 117-119, 120/117-119 and 133/117.

***Response to Arguments***

Applicant's arguments filed 08/27/2002 concerning the filing of a terminal disclaimer and the associated fee have been fully considered but they are not persuasive. Applicant has indicated in section III of the remarks that "attached hereto please find a copy of both the Terminal Disclaimer and the Credit Card Payment Form filed April 2, 2002." These copies were apparently not received by the office as they are not present in the Application file.

***Allowable Subject Matter***

Claims 117-119, 120/117-119, 133/117, 134/133/117, 136/120/117-119 and 139/134/133/117 are allowed.

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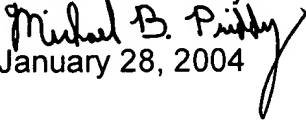
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is (703) 308-8620. The examiner can normally be reached on Mon.-Fri. 8 a.m. - 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael B. Priddy can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Michael B. Priddy

  
January 28, 2004